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EXAMINER

JANVIER, JEAN D

ART UNIT PAPER NUMBER

3622

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/684,737

Applicant(s)

LOPEZ ET AL.

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 69-71, 73-81, 84-98 and 100-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 69-71, 73-81, 84-98 and 100-116 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

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***Response To Applicant's Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

**DETAILED ACTION**

***Specification***

**Claim Status**

Claims 69-71, 73-81, 84-98 and 100-116 are currently pending in the Application.

Claims 72, 82, 83 and 99 have been canceled.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 69-71, 73-76, 78-80, 110-113, 115 and 116 are rejected under 35 U.S.C.

102(e) as being anticipated by Guthrie, US Patent 6, 467, 686B1.

As per claims 69, 70 and 110, Guthrie discloses a system for providing electronic coupons or negotiable economic credits to a user over the Internet or any other computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle. The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. Once the user has uploaded the coupon scanner or handheld device with the desired coupon data, the user can take the coupon scanner to a participating retail store where he can redeem the electronic coupons at the retail store checkout through a POS cradle (docking station 22 of figs. 1, 6 and 7, infrared device interface or wireless device interface) located at the checkout used to upload or transfer the coupon data from the coupon scanner or handheld device to the retail store system (synchronization of POS and the handheld device) and wherein the cradle is an infrared transceiver device interface or wireless device interface. In other words, a wireless connection (wireless communication network) is used during the synchronization process between the coupon scanner or the handheld device and the retail store POS system to transfer coupon data related to at least one electronic coupon or negotiable economic credit from the coupon scanner or handheld device database to the retail store POS system to effect a redemption when the required product is bought during a transaction. It is further to be understood that the user or the bearer of the handheld device initiates the redemption of the at least one electronic coupon and hence, the user authorizes the transfer of the coupon data related to the at least one electronic coupon from the handheld device database or memory to the POS system.

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(Col. 4: 64 to col. 5: 24; col. 7: 48 to col. 8: 24; col. 8: 66 to col. 9: 34; See claims 1, 8 and 22 of the current reference).

As per claims 71, 111, 73-76, 112 and 113, Guthrie discloses a system for providing electronic coupons or negotiable economic credits (representing financial award, financial incentive, cash or simply a discount or an incentive having an associated monetary value) to a user over the Internet or any other computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle. The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. Once the user has uploaded the coupon scanner or handheld device with the desired coupon data, representing at least one coupon having a specific cash value (financial incentive), the user can take the coupon scanner to a retail store where he can redeem the electronic coupons at the retail store checkout through a POS cradle (docking station 22 of figs. 1, 6 and 7) located at the checkout used to upload or transfer the coupon data from the coupon scanner to the retail store system during a redemption process (synchronization of POS and handheld device) (Col. 4: 64 to col. 5: 24).

Moreover, Guthrie teaches a system wherein after redeeming at least one electronic coupon stored within the memory or database of the coupon scanner, subsequent to uploading during a redemption process or synchronization process the at least one electronic coupon data from the coupon scanner to the retail store POS system

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(pricing system) and successfully comparing and matching transmitted coupon data with scannable pricing information, coupon information related to the redeemed electronic coupon is deleted from the memory or database of the coupon scanner where the coupon information was stored to thereby prevent fraud (reconciling data representative of the at least one electronic coupon or negotiable economic credit stored within the memory or database of the coupon scanner or handheld device) (col. 8: 66 to col. 9: 34).

As per claims 78, 79, 115 and 116, Guthrie discloses a system for providing electronic coupons or negotiable economic credits to a user over the Internet or any computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle (docking station 22 of figs. 1, 6 and 7). The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. Once the user has uploaded the coupon scanner or handheld device with the desired coupon data, the user can take the coupon scanner to a retail store where he can redeem at least one electronic coupon at the retail store checkout having a POS cradle (docking station) located at the checkout used to connect the coupon scanner in order to upload or transfer the at least one electronic coupon data from the coupon scanner or handheld device to the retail store system (synchronization of POS and handheld device). And when a product UPC code, stored in a database or product database related to the retail store POS system and read by the retail store POS scanner during a transaction or redemption process, matches a product UPC code in the customer's or user's order, which

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is directly associated with the at least one electronic coupon transferred from the user's coupon scanner or handheld device to the retail store POS system and when the uploaded or transferred electronic coupon information and the validation code respectively compared to the scannable pricing information stored in the POS pricing database (coupon database) and the stored validation code to a corresponding validation code provided by a manufacturer match the scannable pricing information and the provided validation code respectively, the at least one electronic coupon is redeemed accordingly and a price reduction is applied to the customer's order (It is further understood here that coupon data are stored in a database or pricing database or coupon database coupled to the POS system and wherein the stored data are retrieved during redemption and used for validation and comparison purposes is implicitly supported in the art).

(Col. 7: 48 to col. 9: 34) and (Col. 4: 64 to col. 5: 24; col. 7: 48 to col. 8: 24; col. 8: 66 to col. 9: 34; col. 12: 56-62; fig. 9; see also claim 1 of the prior art).

As per claim 80, Guthrie discloses a system for providing electronic coupons or negotiable economic credits to a user over the Internet or any computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle (docking station 22 of figs. 1, 6 and 7). The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. The coupon scanner further contains routines or a coupon management program (coupon management module) within its memory or database for managing the storage and usage of the

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electronic coupon data within the memory of the coupon scanner or handheld device (col. 5: 25-36; col. 8: 15-65; col. 9: 33-34).

**Claims 89-95 and 97-99 are rejected under 35 U.S.C. 102(e) as being anticipated by Bandera, US Patent 6,332,127B1.**

As per claims 89-95 and 97-99, Bandera discloses a method, system and/or computer program product for providing time and location specific advertising object and other information object via a communication means 25 of fig. 1 to a user or customer using a portable terminal or mobile web client 21 of fig. 1, such as a wireless or cell phone, PDA, etc., having a display or screen, an input device and so forth, connected to the communication means or Internet 25 wherein advertising object 32 and an associated coupon object are returned to the user via a web page 26 along with the user's requested information in response to the user accessing a web site for information and wherein an object oriented programming language such as JAVA (software or management module) or more specifically a JAVA Virtual Machine or JVM is running on the portable terminal or handheld device so as to allow JAVA Applets (programs written in JAVA) to run on the portable terminal, thereby selecting advertisements to be displayed on the screen of the portable terminal based on the present location, and/or time of the day, associated with the mobile web client or portable terminal used by the user. The advertisement object and the associated coupon are time and location dependent and the coupon is provided to the user as an incentive to encourage the user to read the displayed advertisement, which is returned to the user along with the requested information.



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Coupon data related to the coupon object are downloaded to the user's mobile client for storage in the memory of the mobile client or cell phone, which is adapted to store the user's personal information including telephone numbers and calendar information, adapted to communicate with other mobile clients or handheld devices. Once loaded with the coupon data, the user can then take the mobile client to a local store to redeem the stored coupon when the mobile client is synchronized with the local store POS via an IR, RF, Bluetooth or wireless link (col. 9: 49 to col. 10: 51; figs. 4, 8 and 9).

(See abstract; figs. 1 and 6; col. 2: 33 to col. 3: 41; col. 5: 26 to col. 6: 24; col. 9: 29-41).

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37

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CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 77, 114, 81 and 84-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guthrie, US Patent 6, 467, 686B1 in view of Biorge et al. (hereinafter Biorge), US Patent 5, 806, 045A.

As per claims 81 and 84, Guthrie discloses a system for providing electronic coupons or negotiable economic credits to a user over the Internet or any other computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle. The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. Once the user has uploaded the coupon scanner or handheld device with the desired coupon data, the user can take the coupon scanner to a participating retail store where he can redeem the electronic coupons at the retail store checkout through a POS cradle (docking station 22 of figs. 1, 6 and 7, infrared device interface or wireless device interface) located at the checkout used to upload or transfer the coupon data from the coupon scanner or handheld device to the retail store system (synchronization of POS and the handheld device) and wherein the cradle is an infrared transceiver device interface or wireless device interface. In other words, a

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wireless connection (wireless communication network) is used during the synchronization process between the coupon scanner or the handheld device and the retail store POS system to transfer coupon data related to at least one electronic coupon or negotiable economic credit from the coupon scanner or handheld device database to the retail store POS system to effect a redemption when the required product is bought during a transaction. It is further to be understood that the user or the bearer of the handheld device initiates the redemption of the at least one electronic coupon and hence, the user authorizes the transfer of the coupon data related to the at least one electronic coupon from the handheld device database or memory to the POS system.

(Col. 4: 64 to col. 5: 24; col. 7: 48 to col. 8: 24; col. 8: 66 to col. 9: 34; See claims 1, 8 and 22 of the current reference).

**As per claims 77, 114, 81, and 84**, Guthrie does not expressly teach providing a new coupon or credit, through the point-of-sale, to the user during the redemption process for storage in the user's handheld device memory or database, nor does he refer to the user's handheld device as a wireless telephone.

However, Biorge teaches a system for providing incentive credits to a user or customer via a handheld or portable device 74 for every qualifying transaction conducted at a participating retailer or provider wherein the value of the incentive credits is contingent upon the value of a current transaction, the number of credit providers involved, the number of monthly transactions conducted by the user (user's purchase history or profile) and some other criteria and programmable options, and wherein the

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customer's incentive credits are stored on the memory of the portable or handheld device 74 where they can be retrieved during a redemption process or synchronization process with a retailer's POS.

At any given time subsequent to storing the earned incentive credits (coupon, financial award, financial incentive or cash) on the customer's handheld device, the customer can take the said device 74 to the same retailer or another participating retailer or provider to redeem at least a portion of the stored incentive credits during a second transaction or a redemption process (synchronization process) wherein the stored incentive credits are transmitted from the customer's handheld device 74 to the retailer's or provider's POS system or base device 72 (during a synchronization process). However, before the redemption or the transaction can take place, the handheld device and the user's identity must be validated or verified to thereby prevent any unauthorized use of the handheld device. The verification process is a twofold scheme. First, the device itself is checked to determine whether it is a proper device for use in the incentive program by having the device exchange encrypted information stored therein with the POS base device 72. Second, the user or the bearer of the device is checked to determine whether he is a valid user by requiring that the user enter a user code and comparing it to a reference user code stored in the memory of the handheld device 74. Only if both the portable device 74 and the user are valid will a transaction or a redemption and/or allocation take place. Once the device 74 and the user are verified to be valid, a transaction between the user and the provider can begin (initialization stage). Further, another level of verification or an extra security check (or redemption authorization) is implemented to verify that the handheld device 74 is active and valid to ensure that the

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customer or user is not using a lost device. To do so, the handheld device processor determines if the current transaction that is about to take place is the first transaction made using the device in a long period of time by reading the user's transaction history profile or journal, comprising transaction amounts, available incentive credits, incentives redeemed, the sources or the names of incentive providers, the products or services purchased, etc., stored in a local database or memory of the user's device 74. The device 74 processor might also query the device local database to determine if the current transaction involving, for example a redemption, does fit the user's transaction pattern as read from the user's profile stored in the local device database. Following the above initial verification or validation and the extra security check (provided that they successful), a redemption of a portion of earned incentive credits stored in the memory of the device 74 may occur provided that the portion specified by the user does not exceed a predefined threshold limit as read from the device 74 local database. And the user earns user new incentives during the current transaction based on the amount of the current transaction, the user's past transaction history (profile) and based upon a predetermined allocation threshold limit. In other words, the user's profile (past transaction history, redemption authorized limits, etc.) is used as an extra layer of security to validate a transaction or redemption of a portion of available stored credits during synchronization between the device 74 and the retailer's POS.

At the conclusion of the redemption process, the redeemed incentive credits are subtracted from the stored incentive credits and the portable device 74 memory is updating accordingly (reconciliation process). Finally, during the redemption process or second transaction (synchronization process), the retailer's POS system or base device 72

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transfers newly earned incentive credits to the customer's handheld device 74 based on the value of the second or current transaction, the number of incentive providers involved, the user's past transaction history.

(See abstract; col. 6: 49 to col. 7: 64; figs. 1-3) and (col. 2: 18-21; col. 4: 62 to col. 5: 33; col. 6: 32-43; col. 7: 1-37; col. 10: 65 to col. 12: 10).

In addition, transferring a credit or coupon data from a portable device, such as a PDA, cell phone or wireless phone, pager, etc., to a store POS system during a redemption process or synchronization process, via an IR link, wireless connection, wireline connection, RF link, Bluetooth radio standard connection or a serial cable, is old and well established in the industry. Here, the type of a wireless device, for instance a cell phone, used to implement the system is a matter of preference ("Official Notice").

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the teachings of Biorge (the above disclosure) into the incentive distribution system of Guthrie so as to provide a new negotiable economic credit or a new coupon or new incentive credits to a customer for conducting a business transaction at a participating retailer while redeeming an original negotiable economic credit or a portion of the accumulated incentive credits or coupon retrieved from the customer's handheld device (wireless telephone) or coupon scanner local database based on the customer's or user's profile, such as past purchase history, the number of redeemed or allocated credits authorized under the user's code, etc., as read from the handheld device local database, wherein the new incentive credits earned according to a

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preset threshold allocation limit are transmitted from the participating retailer's POS system to the customer's handheld device (PDA, cell phone, pager, etc.,) via a docking station interface, an infrared transceiver interface, a wireless device interface or wireless connection, etc., where they are stored in permanent memory until they are retrieved and redeemed during a future transaction at a participating POS, thereby providing an extra layer of security in redeeming or allocating incentive credits through the user's handheld device by using the customer's profile, such as past purchase history or purchasing pattern, stored in the device to determine whether the device has not been used in a transaction for a long period of time or the current transaction does not fit the customer's purchasing pattern or habit as read from the device local database in order to prevent unauthorized or fraudulent use of the device by an unscrupulous user, while encouraging the customer to return to a participating or associated retailer to redeem the accumulated incentives including the newly earned incentives according to a preset redemption threshold limit and earn more incentive credits during the redemption transaction contingent upon the current transaction amount, the number of incentive providers involved, the user's purchase history and a preset threshold allocation limit.

As per claims 85-88, using a wireless personal area network (such as a Bluetooth network), a wireless telecommunications network, a Wireless Intelligent Network (WIN) or a CDMA network as opposed to a regular wireless network (such as a RF or IR as taught by Guthrie) during the transfer of data (synchronization process) between the customer's handheld device and the store POS system is a matter of desires, design choice, design consideration or great convenience, which does not directly impact the

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utility or functionality of the system or simply the transfer of coupon data or credit information between the handheld device and the store POS system to thereby perform a redemption or provide a credit to the customer during a transaction at the POS, wherein the credit is transmitted to the handheld device for storage and later retrieval. The latter findings (conclusion) are well within the skills of an ordinary artisan. Further, Guthrie never limits his system to a specific wireless network. In other words, broadly interpreting the teachings of Guthrie, the use of other well known wireless networks or technologies are herein expected as would have understood one of ordinary skill in the art.

In addition, transferring a credit or coupon data from a portable device, such as a PDA, cell phone or wireless phone, pager, etc., to a store POS system during a redemption process or synchronization process, via an IR link, wireless connection, wireline connection, RF link, Bluetooth radio standard connection or a serial cable, is old and well established in the industry. ("Official Notice").

Therefore, an ordinary skilled artisan, reading or using the system of Guthrie, would have reached the above conclusion and would have been motivated at the time of the invention to consider utilizing other wireless networks to transmit coupon data or credit information between the customer's handheld device and the store POS system to thereby rendering the system more flexible by including other stores that may have installed other wireless networks at their locations instead of RF or IR to perform data transmission between the customer's handheld device and the other store POS systems.



**Claims 89-95, 97-99 and 100-109 are rejected under 35 USC 103(a) as being unpatentable over the combination of Guthrie and view of Bandera, US Patent 6,332,127B1.**

As per claims 89 and 100, Guthrie discloses a system for providing electronic coupons or negotiable economic credits to a user over the Internet or any other computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle. The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. Once the user has uploaded the coupon scanner or handheld device with the desired coupon data, the user can take the coupon scanner to a participating retail store where he can redeem the electronic coupons at the retail store checkout through a POS cradle (docking station 22 of figs. 1, 6 and 7, infrared device interface or wireless device interface) located at the checkout used to upload or transfer the coupon data from the coupon scanner or handheld device to the retail store system (synchronization of POS and the handheld device) and wherein the cradle is an infrared transceiver device interface or wireless device interface. In other words, a wireless connection (wireless communication network) is used during the synchronization process between the coupon scanner or the handheld device and the retail store POS system to transfer coupon data related to at least one electronic coupon or negotiable economic credit from the coupon scanner or handheld device database to the retail store POS system to effect a redemption when the required product is bought during

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a transaction. It is further to be understood that the user or the bearer of the handheld device initiates the redemption of the at least one electronic coupon and hence, the user authorizes the transfer of the coupon data related to the at least one electronic coupon from the handheld device database or memory to the POS system.

(Col. 4: 64 to col. 5: 24; col. 7: 48 to col. 8: 24; col. 8: 66 to col. 9: 34; See claims 1, 8 and 22 of the current reference).

**As per claims 89 and 100**, Guthrie does not expressly disclose using a handheld device adapted to communicate with other handheld devices via a wireless network, adapted to store telephone numbers and calendar information.

However, Bandera discloses a method, system and/or computer program product for providing time and location specific advertising object and other information object via a communication means 25 of fig. 1 to a user or customer using a portable terminal or mobile web client 21 of fig. 1, such as a wireless or cell phone, PDA, etc., having a display or screen, an input device and so forth, connected to the communication means or Internet 25 wherein advertising object 32 and an associated coupon object are returned to the user via a web page 26 along with the user's requested information in response to the user accessing a web site for information and wherein an object oriented programming language such as JAVA (software or management module) or more specifically a JAVA Virtual Machine or JVM is running on the portable terminal or handheld device so as to allow JAVA Applets (programs written in JAVA) to run on the portable terminal, thereby selecting advertisements to be displayed on the screen of the portable terminal based on

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the present location, and/or time of the day, associated with the mobile web client or portable terminal used by the user. The advertisement object and the associated coupon are time and location dependent and the coupon is provided to the user as an incentive to encourage the user to read the displayed advertisement, which is returned to the user along with the requested information. Coupon data related to the coupon object are downloaded to the user's mobile client for storage in the memory of the mobile client or cell phone, which is adapted to store the user's personal information including telephone numbers and calendar information, adapted to communicate with other mobile clients or handheld devices. Once loaded with the coupon data, the user can then take the mobile client to a local store to redeem the stored coupon when the mobile client is synchronized with the local store POS via an IR, RF, Bluetooth or wireless link (col. 9: 49 to col. 10: 51; figs. 4, 8 and 9).

(See abstract; figs. 1 and 6; col. 2: 33 to col. 3: 41; col. 5: 26 to col. 6: 24; col. 9: 29-41).

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the teachings of Bandera into the incentive distribution system of Guthrie so as to use a handheld device, such as a wireless telephone, capable of wirelessly communicating with other handheld devices, capable of storing telephone numbers and calendar information in addition to coupon data and user's identification information, thereby rendering the handheld device more useful to the user who can use the handheld device to contact other users while on the road, to store personal data, store coupon information and to redeem stored coupon data, while increasing the coupon

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distribution and redemption rate significantly by enabling the user of the device not only to use the device for his personal use, but also to participate in the promotional program.

**Claims 96 and 100 are rejected under 35 USC 103(a) as being unpatentable over the combination of Guthrie and Bandera and further in view of Biorge.**

As per claims 96 and 100, the combination of Guthrie and Bandera does not expressly teach providing a new coupon or credit, through the point-of-sale, to the user during the redemption for storage in the user's handheld device memory or database

However, Biorge teaches a system for providing incentive credits to a user or customer via a handheld or portable device 74 for every qualifying transaction conducted at a participating retailer or provider wherein the value of the incentive credits is contingent upon the value of a current transaction, the number of credit providers involved, the number of monthly transactions conducted by the user (user's purchase history or profile) and some other criteria and programmable options, and wherein the customer's incentive credits are stored on the memory of the portable or handheld device 74 where they can be retrieved during a redemption process or synchronization process with a retailer's POS.

At any given time subsequent to storing the earned incentive credits (coupon, financial award, financial incentive or cash) on the customer's handheld device, the customer can take the said device 74 to the same retailer or another participating retailer or provider to redeem at least a portion of the stored incentive credits during a second

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transaction or a redemption process (synchronization process) wherein the stored incentive credits are transmitted from the customer's handheld device 74 to the retailer's or provider's POS system or base device 72 (during a synchronization process). However, before the redemption or the transaction can take place, the handheld device and the user's identity must be validated or verified to thereby prevent any unauthorized use of the handheld device. The verification process is a twofold scheme. First, the device itself is checked to determine whether it is a proper device for use in the incentive program by having the device exchange encrypted information stored therein with the POS base device 72. Second, the user or the bearer of the device is checked to determine whether he is a valid user by requiring that the user enter a user code and comparing it to a reference user code stored in the memory of the handheld device 74. Only if both the portable device 74 and the user are valid will a transaction or a redemption and/or allocation take place. Once the device 74 and the user are verified to be valid, a transaction between the user and the provider can begin (initialization stage). Further, another level of verification or an extra security check (or redemption authorization) is implemented to verify that the handheld device 74 is active and valid to ensure that the customer or user is not using a lost device. To do so, the handheld device processor determines if the current transaction that is about to take place is the first transaction made using the device in a long period of time by reading the user's transaction history profile or journal, comprising transaction amounts, available incentive credits, incentives redeemed, the sources or the names of incentive providers, the products or services purchased, etc., stored in a local database or memory of the user's device 74. The device 74 processor might also query the device local database to determine if the current

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transaction involving, for example a redemption, does fit the user's transaction pattern as read from the user's profile stored in the local device database. Following the above initial verification or validation and the extra security check (provided that they successful), a redemption of a portion of earned incentive credits stored in the memory of the device 74 may occur provided that the portion specified by the user does not exceed a predefined threshold limit as read from the device 74 local database. And the user earns user new incentives during the current transaction based on the amount of the current transaction, the user's past transaction history (profile) and based upon a predetermined allocation threshold limit. In other words, the user's profile (past transaction history, redemption authorized limits, etc.) is used as an extra layer of security to validate a transaction or redemption of a portion of available stored credits during synchronization between the device 74 and the retailer's POS.

At the conclusion of the redemption process, the redeemed incentive credits are subtracted from the stored incentive credits and the portable device 74 memory is updating accordingly (reconciliation process). Finally, during the redemption process or second transaction (synchronization process), the retailer's POS system or base device 72 transfers newly earned incentive credits to the customer's handheld device 74 based on the value of the second or current transaction, the number of incentive providers involved, the user's past transaction history.

(See abstract; col. 6: 49 to col. 7: 64; figs. 1-3) and (col. 2: 18-21; col. 4: 62 to col. 5: 33; col. 6: 32-43; col. 7: 1-37; col. 10: 65 to col. 12: 10).

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the teachings of Biorge into the systems of Guthrie and Bandera systems so as to use a handheld device, such as a wireless telephone, capable of wirelessly communicating with other handheld devices, capable of storing telephone numbers and calendar information in addition to coupon data and user's identification information and to provide a new negotiable economic credit or a new coupon or new incentive credits to a customer or user for conducting a business transaction at a participating retailer while redeeming an original negotiable economic credit or a portion of the accumulated incentive credits or coupon retrieved from the customer's handheld device (wireless telephone) or coupon scanner local database, during a wireless synchronization between the handheld device and the retailer's POS, based on the customer's or user's profile, such as past purchase history, the number of redeemed or allocated credits authorized under the user's code, etc., as read from the handheld device local database, wherein the new incentive credits earned according to a preset threshold allocation limit are transmitted from the participating retailer's POS system to the customer's handheld device (PDA, cell phone, pager, etc.,) via a docking station interface, an infrared transceiver interface, a wireless device interface or wireless connection, etc., where they are stored in permanent memory until they are retrieved and redeemed during a future transaction at a participating POS, thereby rendering the handheld device more useful to the user who can use the device, having the extra capability, to contact other users while on the road, to store personal data, store coupon information and to redeem stored coupon data, while increasing the coupon distribution and redemption rate significantly by enabling the user of the device not only to use the

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device for his personal use, but also to participate in the promotional program and while at the same time providing an extra layer of security in redeeming or allocating incentive credits through the user's handheld device by using the customer's profile, such as past purchase history or purchasing pattern, stored in the device to determine whether the device has not been used in a transaction for a long period of time or the current transaction does not fit the customer's purchasing pattern or habit as read from the device local database in order to prevent unauthorized or fraudulent use of the device by an unscrupulous user, while encouraging the customer to return to a participating or associated retailer to redeem the accumulated incentives including the newly earned incentives according to a preset redemption threshold limit and earn more incentive credits during the redemption transaction contingent upon the current transaction amount, the number of incentive providers involved, the user's purchase history and a preset threshold allocation limit.

As per claims 106-109, using a wireless personal area network (such as a Bluetooth network), a wireless telecommunications network, a Wireless Intelligent Network (WIN) or a CDMA network as opposed to a regular wireless network (such as a RF or IR as taught by Guthrie) during the transfer of data (synchronization process) between the customer's handheld device and the store POS system is a matter of desires, design choice, design consideration or great convenience, which does not directly impact the utility or functionality of the system or simply the transfer of coupon data or credit information between the handheld device and the store POS system to thereby perform a redemption or provide a credit to the customer during a transaction at the POS, wherein



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the credit is transmitted to the handheld device for storage and later retrieval. The latter findings (conclusion) are well within the skills of an ordinary artisan. Further, Guthrie never limits his system to a specific wireless network. In other words, broadly interpreting the teachings of Guthrie, the use of other well known wireless networks or technologies are herein expected as would have understood one of ordinary skill in the art.

In addition, transferring a credit or coupon data from a portable device, such as a PDA, cell phone or wireless phone, pager, etc., to a store POS system during a redemption process or synchronization process, via an IR link, wireless connection, wireline connection, RF link, Bluetooth radio standard connection or a serial cable, is old and well established in the industry. ("Official Notice").

Therefore, an ordinary skilled artisan, reading or using the system of Guthrie, would have reached the above conclusion and would have been motivated at the time of the invention to consider utilizing other wireless networks to transmit coupon data or credit information between the customer's handheld device and the store POS system to thereby rendering the system more flexible by including other stores that may have installed other wireless networks at their locations instead of RF or IR to perform data transmission between the customer's handheld device and the other store POS systems.

As per claims 90-95, 97-99 and 101-105, Guthrie discloses a system for providing electronic coupons or negotiable economic credits to a user over the Internet or any other computer network having a server containing a central repository or database storing the

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electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle. The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. Once the user has uploaded the coupon scanner or handheld device with the desired coupon data, the user can take the coupon scanner to a participating retail store where he can redeem the electronic coupons at the retail store checkout through a POS cradle (docking station 22 of figs. 1, 6 and 7, infrared device interface or wireless device interface) located at the checkout used to upload or transfer the coupon data from the coupon scanner or handheld device to the retail store system (synchronization of POS and the handheld device) and wherein the cradle is an infrared transceiver device interface or wireless device interface. In other words, a wireless connection (wireless communication network) is used during the synchronization process between the coupon scanner or the handheld device and the retail store POS system to transfer coupon data related to at least one electronic coupon or negotiable economic credit from the coupon scanner or handheld device database to the retail store POS system to effect a redemption when the required product is bought during a transaction. It is further to be understood that the user or the bearer of the handheld device initiates the redemption of the at least one electronic coupon and hence, the user authorizes the transfer of the coupon data related to the at least one electronic coupon from the handheld device database or memory to the POS system.

(Col. 4: 64 to col. 5: 24; col. 7: 48 to col. 8: 24; col. 8: 66 to col. 9: 34; See claims 1, 8 and 22 of the current reference).

Guthrie discloses a system for providing electronic coupons or negotiable economic credits (representing financial award, financial incentive, cash or simply a discount or an incentive having an associated monetary value) to a user over the Internet or any other computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle. The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. Once the user has uploaded the coupon scanner or handheld device with the desired coupon data, representing at least one coupon having a specific cash value (financial incentive), the user can take the coupon scanner to a retail store where he can redeem the electronic coupons at the retail store checkout through a POS cradle (docking station 22 of figs. 1, 6 and 7) located at the checkout used to upload or transfer the coupon data from the coupon scanner to the retail store system during a redemption process (synchronization of POS and handheld device) (Col. 4: 64 to col. 5: 24).

Moreover, Guthrie teaches a system wherein after redeeming at least one electronic coupon stored within the memory or database of the coupon scanner, subsequent to uploading during a redemption process or synchronization process the at least one electronic coupon data from the coupon scanner to the retail store POS system (pricing system) and successfully comparing and matching transmitted coupon data with scannable pricing information, coupon information related to the redeemed electronic coupon is deleted from the memory or database of the coupon scanner where the coupon information was stored to thereby prevent fraud (reconciling data representative of the at

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least one electronic coupon or negotiable economic credit stored within the memory or database of the coupon scanner or handheld device) (col. 8: 66 to col. 9: 34).

Guthrie discloses a system for providing electronic coupons or negotiable economic credits to a user over the Internet or any computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle (docking station 22 of figs. 1, 6 and 7). The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. Once the user has uploaded the coupon scanner or handheld device with the desired coupon data, the user can take the coupon scanner to a retail store where he can redeem at least one electronic coupon at the retail store checkout having a POS cradle (docking station) located at the checkout used to connect the coupon scanner in order to upload or transfer the at least one electronic coupon data from the coupon scanner or handheld device to the retail store system (synchronization of POS and handheld device). And when a product UPC code, stored in a database or product database related to the retail store POS system and read by the retail store POS scanner during a transaction or redemption process, matches a product UPC code in the customer's or user's order, which is directly associated with the at least one electronic coupon transferred from the user's coupon scanner or handheld device to the retail store POS system and when the uploaded or transferred electronic coupon information and the validation code respectively compared to the scannable pricing information stored in the POS pricing database (coupon database) and the stored validation code to a corresponding validation code provided by a manufacturer match the

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scannable pricing information and the provided validation code respectively, the at least one electronic coupon is redeemed accordingly and a price reduction is applied to the customer's order (It is further understood here that coupon data are stored in a database or pricing database or coupon database coupled to the POS system and wherein the stored data are retrieved during redemption and used for validation and comparison purposes is implicitly supported in the art).

(Col. 7: 48 to col. 9: 34) and (Col. 4: 64 to col. 5: 24; col. 7: 48 to col. 8: 24; col. 8: 66 to col. 9: 34; col. 12: 56-62; fig. 9; see also claim 1 of the prior art).

Guthrie discloses a system for providing electronic coupons or negotiable economic credits to a user over the Internet or any computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle (docking station 22 of figs. 1, 6 and 7). The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. The coupon scanner further contains routines or a coupon management program (coupon management module) within its memory or database for managing the storage and usage of the electronic coupon data within the memory of the coupon scanner or handheld device (col. 5: 25-36; col. 8: 15-65; col. 9: 33-34).

### **Conclusion**

The following references, although not officially used, are considered to be highly relevant.

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US Patent 6, 450, 407B1 discloses the use of a handheld device for storing coupon data, electronic money, advertisements and a customer's buying history (profile).

US Patent 5, 870, 030 to Deluca discloses a system for providing a coupon to a customer for answering quizzes related to advertisements displayed on the customer's pager and wherein the coupon data are downloaded from a remote system and uploaded on the customer's pager memory for permanent storage and wherein the pager having a bar code related to the stored coupon is scanned during a redemption process at a POS terminal (fig. 8; col. 10: 29 to col. 11: 2; col. 12: 26-45).

US Patent 6, 332, 128 to Nicholson discloses a system for providing a multi-level discount coupons to a customer wherein the discount coupons are encoded on a RF device, such as a transponder.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

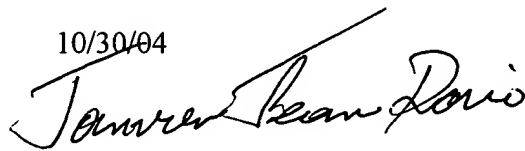
Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ

10/30/04

A handwritten signature in black ink, appearing to read "Jean D. Janvier", is written over the date "10/30/04". The signature is fluid and cursive.